

REMARKS

The Examiner's attention to the present application is noted with appreciation.

The Examiner rejected claims 1 and 14 under 35 U.S.C. § 112 as being indefinite for using the phrase "low fat content". The claims have been amended such that they no longer use that phrase.

The Examiner rejected claims 1, 3, 6-8, 11-16, 18, 21, 22, 25, and 29-52 under 35 U.S.C § 103(a) as being unpatentable over Edson, in view of prior art cited in Applicant's specification, and further in view of Cammarn et al. and still further in view of Avera, and yet still even further in view of Stockton, and yet still even further in view of Rombauer. This rejection is traversed, particularly as to the amended claims.

Applicant's independent claims 1, 14, 33 and 42 recite "...the process ... having nut particles ranging in size from about 1.5 to about 3.5 mm ... not containing hydrogenated oils, not containing an emulsifier, not containing stabilizers and not containing a bulking agent." It is believed that these limitations overcome the Examiner's rejections since none of the prior art references disclose nut particle size and each of the prior art references cited contains at least one hydrogenated oil, emulsifier, stabilizer and/or bulking agent. For example, Edson uses flour or fluids which are considered bulking agents (see Edson Col. 1, lines 38-39). Cammarn et al. use soybean and rapeseed hardstock as stabilizers (see Cammarn et al. Col. 4, line 46). Avera uses lightly hydrogenated or hardened oil as stabilizers (see Avera Col. 2, line 56). Stockton also uses hydrogenated oils as stabilizers (see Stockton Col. 5, line 65 to Col. 6, line 3). All of the prior art references relied on by the Examiner contain ingredients which Applicant's recited claims do not have. In addition, none of the prior art references cited by the Examiner specify or even mention ranges of nut particle size.

Even if particle size were disclosed in one or more of the prior art references, the particle size range recited by Applicant would not be the particle size of the prior art references. In other words, the prior art references would not utilize the same particle size as Applicant. For instance, Edson teaches peanuts that are "ground into a fluid or semi-fluid state, having a consistency of rather thick or heavy molasses or cream" (see Edson lines 29-32). Thus, a nut particle size in Edson would not be nearly as large as Applicant's 1.5 to 3.5 mm particle size. Further, Avera discloses that a "slurry is passed through

a fine mill **12**, that grinds the solids to a sufficiently small size to make a smooth product. It is preferably ground so that at least 96 percent will pass through a standard U.S. sieve of 200 mesh size" (see Avera Col. 2, lines 65-68). Applicant's nut particle size range of 1.5 to 3.5 mm could not pass through a sieve of 200 mesh size (0.076 mm). Stockton teaches that "ordinarily, fine grinding is preferred" (see Stockton lines 59-60), thus teaching away from the coarse grinding of Applicant's recited claims. Finally, Cammarn discloses a "nut paste of pumpable consistency" (see Cammarn Col. 2, line 36). A nut paste of pumpable consistency is inconsistent with and teaches away from the particle size recited by Applicant's amended claims. Therefore, even if a nut particle size was disclosed by the prior art references, which it is not, the prior art references' nut particle size would be much smaller than the nut particle size recited by Applicant.

In rejecting Applicant's claims, the Examiner relies on the combination of not one, two, three, four or even five references, but six different references. In so doing, the Examiner is forced to combine references that teach away not only from each other, but which also teach away from Applicant's claimed invention. Applicant's amended claims recite a process having nut particles range in a size ranging from about 1.5 to about 3.5 mm and not containing hydrogenated oils, not containing an emulsifier, not containing stabilizers and not containing a bulking agent. No where do the prior art references cited by the Examiner even mention a nut particle size range.

Stockton, at columns 5 and 6, goes into great detail about how that invention relies on hydrogenated oils and/or other stabilization oils to prevent separation of the peanut oil from the peanut solids. Accordingly, that reference relies upon a principal problem which Applicant's invention seeks to address and the use of hydrogenated oils and/or other stabilization oils is thus the antithesis of Applicant's claimed invention. In addition, it is important to note that the Examiner has misquoted Stockton such that an interpretation is provided by the Examiner which is the exact opposite of what Stockton obviously intended. That is to say, the Examiner asserted that "Stockton discloses that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103)". What Stockton actually discloses at the portion cited is: "[t]his difficulty of oil separation being foreseen may in only a very partial degree be

prevented by coarse grinding; for the finer the grinding of the kernels the more pronounced the tendency to gravitational separation. But coarse ground peanut butter is less desirable. It is mealy and does not spread well, and furthermore it is less readily digested than fine ground butter. Another expedient that has been resorted to, to prevent in some measure this gravitational separation is to diminish the value of the fraction of oil in the mass. . .”, (emphasis added). Thus not only does Stockton teach away from coarse grinding to control oil separation, but Stockton also teaches away from Applicant’s claimed invention by denouncing coarse grinding and graphically describing the less than desirable results that are associated with Applicant’s coarse grind. Further, Stockton fails to give any examples of nut particle sizes as recited by Applicant’s amended claims.

Avera teaches away from Applicant’s claimed invention and some of the other cited references by relying on the use of blanched nuts (see Avera Abstract). The additional step of blanching nuts not only significantly increases the cost and complexity of the overall process, but can also break apart some nuts and thus results in a portion of the raw materials being discarded, and thus wasted. Because Applicant’s invention teaches away from the increased costs, complexity, and wastefulness associated with blanching the nuts, and because it is believed that Applicant’s use of blanched nuts helps reduce residual natural oils released from grinding the nuts, Applicant’s claims are directed to the use of un-blanched nuts. Avera thus teaches away from Applicant’s claimed invention, which recites “introducing whole, unblanched nuts into a mill”.

Cammarn et al. teach a system which relies on a stabilizer. Because Applicant’s amended independent claims recite “the process not containing stabilizers”, Cammarn et al. thus teach away from Applicant’s claimed invention.

Because several of the prior art references cited by the Examiner teach away from each other, the Examiner’s proposed modifications to them, in an attempt to result in Applicant’s claimed invention, thus renders the prior art inventions being modified unsatisfactory for their intended purpose. In *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), the claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end

of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

Because none of the prior art references cited by the Examiner disclose nut particle size ranges as recited by Applicant's amended claims; and because the individual inventive concepts of Applicant's claimed invention have been selectively culled from the numerous prior art references by the Examiner in a post facto manner; and because the prior art references teach away from Applicant's invention; and because the prior art references teach away from each other; and because one skilled in the art would not attempt to so combine the details of the numerous references in such a novel and non-obvious manner; and because the Examiner's combination of the numerous prior art references renders them unsatisfactory for their intended purpose, the novel combination of the prior art references cited by the Examiner is thus inappropriate in rejecting Applicant's amended claims.

The Examiner rejected claims 1, 5, 14, 25, 31-33, 35, 42, and 45-48 under 35 U.S.C § 102(b) as being anticipated by Rombauer et al. This rejection is traversed, particularly as to the amended claims. Rombauer et al. fail to disclose or even mention nut particle size, much less a specific range of nut particle size as taught in Applicant's amended claims 1, 14, 33 and 42. Therefore, Rombauer et al. fail to anticipate each and every element of Applicant's amended independent claims.


In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection and objection have been traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

The fee for additional claims is included. Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Respectfully submitted,

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